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| 09/992,811      | 11/19/2001  | Shawn Buchanan Greene | 16911-8484          | 7339             |

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THOMPSON COBURN, LLP  
ONE US BANK PLAZA  
SUITE 3500  
ST LOUIS, MO 63101

EXAMINER

CUFF, MICHAEL A

ART UNIT PAPER NUMBER

3627

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992,811

Applicant(s)

GREENE, SHAWN BUCHANAN

Examiner

Michael Cuff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***


1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18 and 32-40, drawn to a method of selling recordings.
  - II. Claims 19-23 and 28-31, drawn to a method of selling licenses.
  - III. Claims 24-27, drawn to a method of selling collector items.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention has separate utility in that each method of selling a recording, a license, or a collector item can be done totally independent and separate from each other. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Thomas Polcyn on 8/11/03 a provisional election was made without traverse to prosecute the invention of I, claims 1-18 and 32-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.



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***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 and 32-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-18, 32-37 and 39-40 show a series of steps which are grounded in the abstract idea of, for example, providing, recording, determining and calculating. The broadly recited steps do not recite sufficient computer structures that are within "technological arts". Therefore, they do not satisfy the statutory requirements of 35 USC 101. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

The changes to fix this issue are relatively minor. For example, Claim 1 could be re-written so that the fourth step read --calculating, by a computer, a desirable number ... --. Notice that claim 38 is fine because it recites a computer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Stonedahl. (To be clear, the examiner is using the filing date of the provisional application of the published Stonedahl application as the effective 102(e) filing date, which is June 20, 2001.)

Stonedahl shows, figure 1, a system for capturing and distributing event recordings. Figure 1 shows a live event system 300 (conducting live event). There is a central recording module 105 (recording live event). The attendee of the live event 101 uses a small handheld selection device 102, supplied to them by the event management to make the selections during the event (pre-purchased at event POS; page 3, second column, bottom). The selection device may relay information to an order processing system 111. The order collection system uses the information to generate production orders (calculating number of copies) that are formatted for use by a production facility 113 (manufacturing; page 3, first column, middle). The custom CD or other media can be delivered (distributing) to the attendee in as little as a matter of hours (cut off time/date) after the event. The system contains "local event centers" (box office, POS) at or near the event venue and "remote event centers" which are accessible by network connections, a web site interface, data or voice phone line connections, or by a physical store front (capable of receiving mail) or automated sales kiosk (page 3, first column, top). Customers can initiate the purchase process before, during and after the live event.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stonedahl in view of Griner et al.

Stonedahl shows all of the limitations of the claims except for specifying having the manufacturing on site and distributing the recording before the attendees exit the venue.

Stonedahl shows, figure 1, a system for capturing and distributing event recordings. Figure 1 shows a live event system 300 (conducting live event). There is a central recording module 105 (recording live event). The attendee of the live event 101 uses a small handheld selection device 102, supplied to them by the event management to make the selections during the event (pre-purchased at event POS; page 3, second column, bottom). The selection device may relay information to an order processing system 111. The order collection system uses the information to generate production orders (calculating number of copies) that are formatted for use by a production facility 113 (manufacturing; page 3, first column, middle). The custom CD or other media can be delivered (distributing) to the attendee in as little as a matter of hours (cut off time/date) after the event. The system contains "local event centers" (box office, POS) at or near the event venue and "remote event centers" which are

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accessible by network connections, a web site interface, data or voice phone line connections, or by a physical store front (capable of receiving mail) or automated sales kiosk (page 3, first column, top). Customers can initiate the purchase process before, during and after the live event.

Griner et al. teaches, figure 1, a system for creating recordings of live performances to be available shortly after the event has ended (recording module on site and recording available to attendees before exiting the venue) in order to provide immediate and quick service to the customer.

Based on the teaching of Griner et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the Stonedahl system to incorporate the faster manufacturing system of Griner et al. in order to provide immediate and quick service to the customer.

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**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lappington et al. and Cruz et al. show recording systems of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cuff whose telephone number is (703) 308-0610. The examiner can normally be reached on 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Michael Cuff  
August 11, 2003